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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/574,843	04/06/2006	Shinichi Yanagi	288920US0PCT	5093
22850	7590	07/24/2008		
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			EXAMINER OLADAPO, TAIWO	
			ART UNIT	PAPER NUMBER
			1797	
			NOTIFICATION DATE	DELIVERY MODE
			07/24/2008	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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<b>Office Action Summary</b>	<b>Application No.</b> 10/574,843	<b>Applicant(s)</b> YANAGI ET AL.	
	<b>Examiner</b> TAIWO OLADAPO	<b>Art Unit</b> 1797	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 06 April 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |                                                                                        |                                                                   |
|----------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>4/6/2006; 5/15/2007; 6/5/2008</u> .                           | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1 – 7 are rejected under 35 U.S.C. 102(b) as being anticipated by Kablaoui et al. (US 4,028,258)

3. In regards to claim 1, Kablaoui teaches a lubricating oil additive for automatic transmission fluids comprising a reaction product of a succinimide compound and phosphorus compound such as zinc dialkyldithiophosphate (ZDDP) used as antiwear additive (abstract, column 4 lines 27 – 40). Kablaoui teaches that the lubricating oil additive comprises a reaction product of various additives such as dispersant, friction modifier, VI improver, wear inhibitor (i.e., ZDDP), corrosion inhibitors, antioxidant and demulsifier (column 4 lines 26 – 47).

4. In regards to claims 2 – 4, Kablaoui teaches the lubricating oil additive having ZDDP as stated previously. ZDDP is a diester having two alkyl groups attached to the phosphorus atom.

5. In regards to claim 5, Kablaoui teaches the lubricating oil additive wherein the ZDDP has alkyl or dialkyl groups such as di-nonylphenoxyethyl, di-dodecylphenoxyethyl, or dioctyl which are C<sub>8</sub> to C<sub>10</sub> groups (column 6 lines 16 – 30). These are within the claimed ranges for the carbon atoms.

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6. In regards to claim 6, Kablaoui teaches the lubricating oil additive as stated previously comprising mineral base oil (column 2 lines 1 – 6).
7. In regards to claim 7, Kablaoui teaches the lubricating oil comprising additive useful for automatic transmission which incorporates wet clutches.
8. Claims 1 – 6, 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Hata et al. (EP 1142983 A1)
9. In regards to claims 1, 8, Hata teaches a lubricating oil additive and a lubricant for use in automotive continuous variable transmissions comprising a dialkyl phosphate ester compound having a formula 1, and succinimide dispersant additives [0009, 0011, and 0024].
10. In regards to claims 2 – 4, Hata teaches the lubricating oil additive comprising a dithiophosphate ester having two OR groups (i.e. diester) bonded to the phosphorus atom. The R groups are i.e., C<sub>1</sub> to C<sub>18</sub> alkyl groups [0024].
11. In regards to claim 5, Hata teaches the lubricating oil additive wherein the dithiophosphate ester groups have R groups that are i.e. tert-butyl, pentyl, hexyl, octyl, decyl or cyclo alkyl groups having from 3 to 18 carbons [0015]. These are within the claimed range for the number of carbon atoms.
12. In regards to claim 6, Hata teaches lubricating oil composition comprising additives as previously stated and mineral oil as base oil [0034].
13. Claims 1 – 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Ishida et al. (JP 2002-105478A)
14. In regards to claim 1, Ishida teaches a lubricating oil additive comprising a succinimide compound and phosphorus compound reaction product additives in the oil [0006] [0014]. The

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succinimide compound has the general formula 1 and 2 in the reference. The lubricating oil contains further additives such as phosphate esters, thiophosphate esters (a sulfur containing diester compound), ZDDP [0014].

15. In regards to claims 2 – 5, Ishida teaches the lubricating oil additive comprising dithiophosphate ester having two alkyl groups bonded to phosphorus such as di-2-ethylhexyl dithiophosphate zinc [0014]. The ZDDP compound is a diester as previously stated. The alkyl group's ethylhexyl of the ZDDP both have carbon atoms in the claimed range.

16. In regards to claim 6, Ishida teaches the lubricating oil composition comprising an additive as previously stated; wherein base oil is synthetic or mineral oil [0005].

17. In regards to claims 7, 8, Ishida teaches the lubricating oil composition comprising an additive useful to lubricating wet clutch or wet brake and a continuously variable transmission (or variable speed gear) [0001, 0004].

### ***Conclusion***

18. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. They are 6,362,136; 6,352,962; 5,712,230; 5,354,485.

19. The International search report dated 06/05/2008 provides 4 X references, however the references by Kablaoui et al. (US 4,028,258) and Hata et al. (EP 1142983 A1) were used for rejection of the instant claims at this time since they seems to better reflect the claimed inventions.

20. The International search report dated 04/06/2006 provides 4 X references, however JP 2002-105478 A is used for rejection of the instant claims at this time since it teaches the further limitation of claim 7, the lubrication of wet clutch or wet brake which the others do not teach.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to TAIWO OLADAPO whose telephone number is (571)270-3723. The examiner can normally be reached on 8:00 - 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Caldarola can be reached on (571)272-1444. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

TO

/Glenn A Caldarola/  
Acting SPE of Art Unit 1797